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EXAMINER

HOOSAIN, ALLAN

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/843,646	PRADHAN ET AL.
	Examiner	Art Unit
	Allan Hoosain	2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 27 April 2001.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-37 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-4 and 6-37 is/are rejected.

7)  Claim(s) 5 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 27 April 2001 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

### *Allowable Subject Matter*

1. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4,6-11,13-15,18,21-26,28-37 are rejected under 35 U.S.C. 102(e) as being anticipated by **Rautila et al.** (US 6,549,625).

As to Claim 1, with respect to Figures 1-4, **Rautila** teaches a method of advertising to a consumer device comprising broadcasting a short range piconet advertisement (Figure 2, label 44);

making an assessment as to whether a response or reply to the advertisement is required, and if so replying to the advertisement via telecommunications (Figure 2, label 46 and Col. 9, lines 12-42).

As to Claim 2, **Rautila** teaches a method according to claim 1 comprising requesting further or fuller details of the advertisement via long range wireless telecommunications (Col. 9, lines 20-28).

As to Claim 3, **Rautila** teaches a method according to claim 1 comprising replying to the advertisement via short range piconet wireless telecommunications (Figure 1, label 14 and Col. 6, lines 36-40).

As to Claim 4, **Rautila** teaches a method according to claim 1 comprising broadcasting a short form advertisement and requesting further or fuller details of the advertisement (Figure 1).

As to Claim 6, **Rautila** teaches a method according to claim 1 in which the advertisement is broadcast by a hand-portable mobile wireless telecommunications device (Col. 8, lines 13-18).

As to Claim 7, **Rautila** teaches a method according to claim 1 in which the advertisement is assessed using a hand portable consumer mobile wireless telecommunications consumer device (Figures 1 and 3).

As to Claim 8, **Rautila** teaches a method according to claim 1 in which receipt of the short form advertisement prompts the consumer device to request more information via the short range

telecommunications automatically if the short form advertisement triggers a trigger to do so (Figure 3).

As to Claim 9, **Rautila** teaches a method according to claim 1 comprising using short range telecommunications, 24, to communicate a short-form advertisement to the consumer device, and short range telecommunications, 27, to communicate a request for a fuller advertisement from the consumer device to an advertiser device, and short range telecommunications, 27', to communicate fuller details from the advertiser device to the consumer device, all taking place within the order of a second or a few seconds (Figure 1); and

using long range telecommunications, 42, to carry a reply to the advertisement to an advertisement reply device which is a different device to that from which the advertisement was broadcast (Figure 1).

As to Claim 10, **Rautila** teaches a method according to claim 1 comprising storing the telecommunications address with which the consumer device is to communicate the reply to the advertisement in the consumer device for display, for automatic dial or for semi-automatic dialling, or both (Figure 3).

As to Claim 11, **Rautila** teaches a method according to claim 1 in which the advertisement is received by a portable telephone, personal digital assistant or other handheld portable electronic device, and in which the assessment as to whether a reply to the advertisement is required is at least in part made by the portable consumer device (Figure 3).

As to Claim 13, **Rautila** teaches a method according to claim 1 comprising:

broadcasting a short range advertisement from an advertiser telecommunications device (Figure 1, label 14);  
receiving the broadcast advertisement on the consumer telecommunications device (Figure 1, label 12); and  
replying to the advertisement via a broker device interposed in the telecommunications link between the advertiser device and the consumer device (Figure 1, label 42).

As to Claim 14, **Rautila** teaches a method according to claim 13 in which the broker device modifies the message sent by the consumer device to the advertiser device, and/or modifies any follow-up message sent by the advertiser device, or a proxy or master advertising device, to the consumer device (Col. 9, lines 1-11).

As to Claim 15, **Rautila** teaches a method according to claim 13, in which the advertiser device does not include its own telecommunications address in its broadcast advert, but does include the telecommunications address of the broker device (Col. 7, lines 12-22).

As to Claim 18, **Rautila** teaches a method according to claim 1 in which the consumer device is used to reply to an advertisement via long range telecommunications (Figure 1, label 42).

As to Claim 21, **Rautila** teaches a method according to claim 1 in which the advertisement is broadcast from a hand-holdable portable, pocketable, wireless advertiser device (Figure 1, label 14).

As to Claim 22, **Rautila** teaches a method according to claim 1 comprising using portable electronic devices for both the advertiser device and the consumer device, the devices both having both piconet short range and long range telecommunication capabilities (Figure 1).

As to Claim 23, with respect to Figures 1-4, **Rautila** teaches a telecommunications advertisement receiving device comprising a short range piconet receiver, 44, and an advertisement filter or assessor, 48, and a long range telecommunications emitter, 46 (Figure 2).

As to Claim 24, **Rautila** teaches a device according to claim 23 comprising a piconet emitter, and being configured so as to emit via its piconet emitter a request for more information about an advertisement upon an advertisement being assessed as being of interest (Figure 1, label 27').

As to Claim 25, **Rautila** teaches a device according to claim 23 comprising a display screen adapted to display the advertisement (Figure 2, label 49').

As to Claim 26, with respect to Figures 1-4, **Rautila** teaches a mobile telecommunications device having a memory, a short range piconet receiver an emitter, and a controller, the controller controlling the device in use to assess messages received by the receiver for a reply

telecommunications address and to store any such reply address in the memory, and the device also having a reply trigger adapted in use to cause the controller to use an address from the memory to send a reply to a received message to the address associated with the relevant incoming message (Figures 1-3).

As to Claim 28, **Rautila** teaches a device according to claim 23 which has a long range telecommunications wireless emitter and which is adapted to reply to a received message via its long range emitter (Figure 1, label 42).

As to Claim 29, **Rautila** teaches a device according to claim 23 which has both piconet and long range telecommunications emitters and receivers and the controller is adapted, in use, to assess the telecommunications reply address associated with a received message to determine whether the reply address is a long range telecommunications address and to cause the reply to be emitted by the appropriate long or short range emitter of the device (Figure 1).

As to Claim 30, **Rautila** teaches a device according to claims 23 in which the controller of the device is adapted to assess a received message to determine whether the message is of a category of interest, and if so request further details or a fuller message via its piconet channel and in which the device is adapted to receive requested further details of a fuller message via its piconet channel; and

the device is adapted to contact a reply address via its long distance telecommunications channel (Figure 1).

As to Claim 31, with respect to Figures 1-4, **Rautila** teaches a mobile telephone or other mobile telecommunications device having both a long range telecommunications transmitter and receiver, and a piconet telecommunications transmitter and receiver, a control processor, and a memory storage medium (Figure 1, label 16);

wherein the memory storage medium contains an advertisement to be transmitted via the piconet transmitter, the control processor being adapted to broadcast the advertisement over the piconet transmitter and being adapted to monitor piconet signals that are received by the piconet receiver for a reply (Figure 1, labels 14 and 24).

As to Claim 32, **Rautila** teaches a device according to claim 31, in which the control processor is preferably adapted to recognise a piconet received request for further information or a fuller advertisement and to cause such further information or fuller advertisement to be emitted automatically via its piconet emitter upon receipt of a request for said further information (Figure 1, label 27').

As to Claim 33, **Rautila** teaches a device according to claim 31 in which the control processor is adapted to provide a reply telecommunications address in the advertisement or in the further details or fuller advertisement (Figure 3).

As to Claim 34, **Rautila** teaches a device according to claim 33 in which the reply telecommunications address is not the address of the device (Figure 3).

As to Claim 35, **Rautila** teaches a device according to claim 33 adapted to provide in the advertisement or further detail or fuller advertisement both a long range, non-piconet, reply address and a piconet reply address (Figure 1, labels 27 and 27').

As to Claim 36, with respect to Figures 1-4, **Rautila** teaches a network comprising an advertiser device comprising a hybrid mobile telephone, or other telecommunications device, having both a short range transmitter and receiver, and also a long range telecommunications transmitter and receiver, a memory, and a control processor (Figure 1, label 14);

the memory containing both a short-form advertisement and a longer more detailed advertisement related to the short-form advertisement (Col. 7, lines 1-11);

a consumer device, 12, comprising a hybrid mobile telephone, or other telecommunications device, having both a short range, piconet, transmitter and receiver, and also a long range telecommunications transmitter and receiver, a memory and a control processor, the consumer device being adapted to request the longer advertisement for the advertiser device following receipt of that short-form advertisement of interest (Figure 2 and Col. 9, lines 1-11).

As to Claim 37, **Rautila** teaches a network according to claim 36 also including a remote advertisement broker or advertisement reply device contactable via the long range emitter of the consumer device, and capable of contacting the advertiser device by the long range receiver of the advertiser device (Figure 1).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 12,16-17,19-20,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rautila** in view of **Slettengren et al.** (US 2002/0028674).

As to Claims 12, 16-17,27, **Rautila** teaches a method according to claim 11 in which the advertisement received by the mobile device:

**Rautila** does not teach the following limitation:

“is screened against an advertisement profile filter by the device before being presented to the user of the device, and is only presented to the user if the advertisement passes the screening operation”

**Slettengren** teaches a control profile for screening incoming communications (P0038, P0039 and P0040). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add control profile capability to **Rautila**'s invention for controlling which communications to accept as taught by **Slettengren**'s invention in order to provide a user with alerts for selected communications.

As to Claims 19-20, **Rautila** teaches a method according to claim 1 comprising sending:

**Rautila** does not teach the following limitation:

“a first part of an advertisement via the short range telecommunications, and a second, longer or larger, part of the advertisement via short range telecommunications, the second part of the advertisement being transmitted after the consumer device has screened the first part of the advertisement and has requested the second part of the advertisement”

**Slettengren** teaches incoming communications using sub-type identifiers (first part of an advertisement) and further sub-types (second or longer part of the advertisement) (P0058). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add sub-type capability to **Rautila**'s invention for identifying communications as taught by **Slettengren**'s invention in order to provide a user with alerts for selected communications.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Cannon et al.** (US 6,650,871) teach wireless devices which communicate with short range and long range transceivers.

**Liu et al.** (US 2002/0077896) teach transmitting screened advertisements to users mobile devices.

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231  
or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

*Allan Hoosain*  
**Allan Hoosain**  
**Primary Examiner**  
1/5/04